

fiber component comprising nylon and chitin, an antistatic component comprising chitin, and said whole processed apple extract comprising a natural apple fiber component.

REMARKS

The Examiner finds that the definition of the term "extract" in the specification based on a preparation using seedless but otherwise whole fruit or vegetable does not mean that the extract is a substantially whole processed fruit or vegetable. Further, the Examiner finds that a limitation in the claims including tacky components of the fruit or vegetable is not present therein, and therefore is not considered in determining patentability. However, Applicants refer to their Preliminary Response of September 23, 2002 wherein amendments are made to Claims 1, 25, and 30 to incorporate that the extract is of tacky constituents. Applicants restate these amendments herein and based on the suggestions of the Examiner in the present office action further amend the claims such that the extract is of at least the tacky constituents and that the extract containing the tacky constituents is of the fruit or vegetable. Thus, the present invention, as amended, is a mascara composition that contains a substantially whole processed fruit or vegetable extract that contains at least the tacky constituents of the fruit or vegetable. Specifically at page 3, lines 24 to 32, the term "extract" is defined to have this special meaning such that the extract is prepared using seedless but otherwise whole fruit or vegetable. The tacky components (e.g., pulp, sugars, and skin) of the fruit or vegetable are not separated or purified to make the whole processed fruit or vegetable extract of the present invention. The nuance of the present invention is the substantially whole processed fruit or vegetable extract whereby the pulp and skin are present in the extract of the present invention, and this is not disclosed by the Pastour reference cited by the Examiner.

The active principle or plant extract of the Pastour reference is not disclosed as containing a tacky constituent of the plant extract. The Examiner finds that the Pastour reference suggests that the plant extract is considered to be an active principle. And applying the meaning of the term plant extract in the Pastour reference this could be the case. However, in contrast to the Pastour plant extract, and what Applicants have been continuously arguing is not that the Pastour does not teach plant extracts as the Examiner has incorrectly set forth, but rather that the plant extract of the present invention is not disclosed by the Pastour reference. In other words, the plant extract of the Pastour reference is not the same as the plant extract of the present invention. The Examiner notes that the Pastour plant extract is considered to be an active principle. The plant extract is, therefore, an active principle isolated from the plant. Thus, the Pastour plant extract, i.e., the active principle is not substantially the whole plant and it does not include the tacky constituents of the plant. This is in contrast to the plant extract of the present invention where the

substantially whole processed plant extract contains the tacky constituents of the plant. Thus, the plant extract of the present invention including the tacky constituents of the substantially whole plant is not disclosed by the Pastour reference. The substantially whole processed extract of the present invention containing tacky constituents is essentially opposite the active principle taught in the Pastour reference, and thus, the Pastour reference fails to disclose, expressly or inherently, the present invention.

Further, the Pastour reference fails to disclose the substantially unfiltered whole processed fruit or vegetable extract dispersed in a silicone oil, and this has not been addressed by the Examiner. Because the Pastour reference does not disclose a seedless but otherwise whole processed fruit or vegetable extract of at least the tacky constituents of the fruit or vegetable, and because it does not disclose any type of fruit or vegetable extract dispersed in a silicone oil, it does not anticipate the present invention, as amended. Therefore, the rejection under 35 U.S.C. §102(b) should be withdrawn.

The Examiner asserts that the Pastour reference also renders the present invention obvious because the Pastour reference teaches plant extract and according to the Examiner, this includes any and all plants. However, as previously pointed out, the Pastour reference does not disclose *carte blanche*, plant extracts, because it merely discloses active principles such as plant extract. The Pastour reference teaches a plant extract as an example of an active principle removed from the other tacky constituents of the plant. So while, the plant extract can include both vegetable and fruit extract, in any and all cases, the extract taken from the vegetable or fruit source is only the active principle, and not its tacky constituents. This has not been addressed by the Examiner. M.P.E.P. 707.07(f). As the Examiner mentions, the expected result is a mascara with beneficial qualities, but assuming *arguendo* that this is true, it would presumably only be so because the plant extract, *inter alia* is taught solely as the active principle. There is no teaching or suggestion in the Pastour reference to incorporate tacky constituents from a whole fruit or vegetable in a mascara composition. Therefore, the Examiner fails to set forth a *prima facie* case of obviousness.

The achievement of the present invention is surprising and unexpected as evidenced by the results provided in the specification and as mentioned in Applicants' previous response of January 2, 2001. However, the Examiner in the present action, as in previous actions, interprets the study described in the present specification to mean that 80% (the actual number is 87%) or more of the participants rate the mascara of the present invention as performing the same as their currently used mascara, and therefore, the Examiner concludes that the results of the present invention are not unexpected. Applicants still assert that this conclusion is not accurate.

The Pastour reference is no different than conventional mascaras, and the ability of the mascara of the present invention to perform as well as traditional mascara is indeed unexpected because it contains

tacky components of the fruit or vegetable which would be expected to cause the mascara to perform poorly. The Examiner responds to this by pointing out that additional ingredients added to a traditional formulation that are discovered to work just as well as the known traditional formulation is not unexpected. Applicants respectfully traverse this line of reasoning because it depends on what the additional ingredients are. For example, if an additional ingredient of titanium dioxide is added to a traditional red lipstick, the expected result would be a pink lipstick; but if the same traditional red lipstick with the additional titanium dioxide produced a comparable red lipstick, this would be unexpected. The present invention is analogous to the unexpected results of the lipstick example. The addition of tacky ingredients to a mascara would be expected to produce a sticky and undesirable mascara composition. The fact that the present invention exhibits comparable characteristics to conventional mascaras is indeed unexpected.

One of ordinary skill in the art would not expect a mascara formula containing whole fruit and vegetable extract with tacky constituents to achieve the desired qualities of a mascara at all, nonetheless to perform comparably to a conventional mascara. However, surprisingly and unexpectedly, the mascara of the present invention containing unfiltered whole processed fruit or vegetable extract (i.e., containing sticky sugary, gummy and tacky pulp) is favorably compared with conventional mascaras that do not contain these ingredients.

Finally, the Pastour reference fails to teach or suggest the whole processed seedless apple extract dispersed in a cyclomethicone as described in Claim 30. The Pastour reference discloses that its aqueous phase can comprise active principles such as plant extracts. There is no teaching or suggestion to add, for example, the whole processed apple extract of tacky constituents to the Pastour compositions. Nor is there any teaching or suggestion to disperse the whole processed apple extract in cyclomethicone. Therefore, in addition to the arguments presented above with respect to the extract of the present invention containing tacky constituents, the specific whole processed apple extract dispersed in cyclomethicone is not taught or suggested by the Pastour reference.

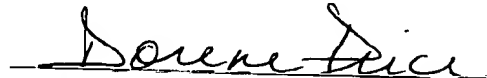
Applicants submit that the amended claims of the present application satisfy the requirements of 35 U.S.C. §103(a) because the Pastour reference fails to teach or suggest a substantially whole processed fruit or vegetable extract of tacky constituents as described in the present specification, and Applicants request that the Examiner's rejection be withdrawn.

CONCLUSION

Applicants believe that the present claims are patentable over the cited prior art reference. Accordingly, the claims, as amended, are believed to be in condition for allowance, and issuance of a Notice of Allowance is respectfully solicited.

Respectfully submitted,

Date March 18, 2003



Dorene M. Price (Reg. No. 43,018)
Estee Lauder Companies
125 Pinelawn Road
Melville, NY 11747
(631) 531-1194

MARKED AMENDMENTS

Please amend Claims 1, 25, and 30 as follows:

1.(Amended) A mascara composition comprising a seedless but otherwise substantially whole processed fruit or vegetable extract of at least tacky constituents of the fruit or vegetable dispersed in a silicone oil.

25.(Amended) A mascara composition comprising a seedless but otherwise substantially whole processed fruit or vegetable extract of at least tacky constituents of the fruit or vegetable dispersed in a volatile silicone oil, an antistatic component, a non-plant fiber component, and said whole processed fruit or vegetable extract comprising a natural fiber component.

30.(Amended) A mascara composition for application to the eyelashes comprising about 0.05 to about 0.50 percent by weight of the composition of a seedless but otherwise substantially whole processed apple extract of at least tacky constituents of the fruit or vegetable dispersed in a cyclomethicone, a non-plant fiber component comprising nylon and chitin, an antistatic component comprising chitin, and said whole processed apple extract comprising a natural apple fiber component.